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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY DOCKET NO.
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EXAMINER

ART UNIT	PAPER NUMBER
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5

DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on May 8, 2001

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), ~~which day~~ whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133) Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-8 are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☒ Claim(s) 1-8 are rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.
☐ received in Application No. (Series Code/Serial Number) _____
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e)

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
☐ Interview Summary, PTO-413
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

09/666,152

DETAILED ACTION

Claims 1-8 are pending in the application.

Election/Restrictions

Applicants' election with traverse of Group V in Paper No. 4 is acknowledged. The traversal is on the ground(s) that an extended search and consideration would save considerable time and expense for Applicants.

Applicants' arguments have been considered but have not been found persuasive. Section 121 provides the Commissioner of Patents and Trademarks with the authority to restrict applications to several claimed inventions when those inventions are found to be independent and distinct. In the instant application, the Examiner has determined that several independent and distinct inventions are claimed in the application. Further, as shown in the previous Office Action, different search considerations are involved for each group which would impose an undue burden on the Examiner and the U.S. PTO resources to examine all of the inventions in a single application.

The requirement is still deemed proper and is therefore made
FINAL.

Subject matter not embraced by elected Group V is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 4.

It is suggested that in order to advance prosecution, the non-elected subject matter be canceled when responding to this Office Action.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

Claims 4, 5, 7 and 8 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claims should refer to other claims in the alternative only and/or cannot depend from any other multiple dependent claim. See MPEP § 608.01(n).

Claims 6 and 8 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C.

112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 3, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

The phrase "a monocyclic group, a polycyclic group or a group of a fused ring" in claim 1 is indefinite because it is unclear if the phrase is defining "Het" or a part of the definition of a heteroatom. In claim 3, "benzene" is misspelled. In claim 3, the phrase "and a pharmaceutical composition containing these compounds" is unclear since claim 3 is directed towards a compound not a composition. The phrase "for preventing for" in claim 7 is unclear.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Mahmoud et al. {Gazz. Chim. Ital., Vol. 112, No. 102, pages 55-56, 1982 or CA 97:72288}, Mahmoud et al. {Eur. J. Med. Chem.-Chim. Ther., Vol. 16, No. 4, pages 383-384, 1981 or CA 95:169076} and Abdel Rahman et al. {J. Indian Chem. Soc., Vol. 58, No. 2, pages 171-173, 1981 or CA 95:42967}.

Each of the above cited references disclose compounds embraced by the instant claims. See page 394 in Mahmoud et al. 1981, page 55 in Mahmoud et al. 1982 and page 171 in Abdel Rahman et al. or see the compounds of CA Registry Numbers 79420-06-7 and 79420-07-8 in Mahmoud et al. 1981, the compound of CA Registry Number 81958-30-

7 in Mahmoud et al. 1982; and the compounds of CA Registry Numbers 78205-06-8, 78205-15-9 and 78205-16-0 and Beilstein Registry Number 6740826 in Rahman et al.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mahmoud et al. {Eur. J. Med. Chem.-Chim. Ther., Vol. 16, No. 4, pages 383-384, 1981}, Mahmoud et al. {Gazz. Chim. Ital., Vol. 112, No. 102, pages 55-56, 1982}, Abdel Rahman et al. {J. Indian Chem. Soc., Vol. 58, No. 2, pages 171-173, 1981}, Hirai et al. {JP 04139172} and Higley et al. {U.S. Pat. 5,290,801}, each taken alone. An English translation of Hirai et al. has been supplied.

Determination of the scope and content of the prior art (MPEP §2141.01)

Applicants claim benzoxazole compounds. Mahmoud et al. 1981 (page 384), Mahmoud et al. 1982 (page 55), Abdel Rahman et al. (page 171), Hirai et al. (pages 1, 2 and 8 of the Japanese patent and page 6 of the English translation) and Higley et al. (columns 7 and 8 and Tables I-III in columns 28-34) each teach benzoxazole compounds which are structurally the same (see 102 rejection above) or structurally similar to the instant claimed compounds.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between some of the compounds of the prior art and the compounds instantly claimed is that of generic description.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

The indiscriminate selection of "some" among "many" is *prima facie* obvious, *In re Lemin*, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (ie., anti-ulcer). One

skilled in the art would have been motivated to prepare compounds embraced by the reference genera to arrive at the instant claimed compounds with the expectation of obtaining additional beneficial compounds which would be useful in treating ulcers. Therefore, the instant claimed compounds would have been suggested to one skilled in the art.

Information Disclosure Statement

It is noted that an Information Disclosure Statement had not been filed at the time of this Office Action. It is suggested that if Applicants intend to file an IDS that it be filed when responding to this Office Action.

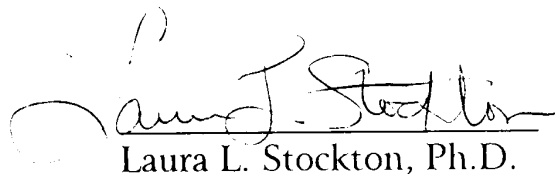
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton, Ph.D. whose telephone number is (703) 308-1875.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

Application/Control Number: 09/666,152
Art Unit: 1626

Page 10

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or 305-3592.

A handwritten signature in cursive script, appearing to read "Laura L. Stockton", is written over a horizontal line.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

May 14, 2001